

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 1, 4, 18, 28, 47, 49, 51 and 55 have been amended. Support for the amended claims may be found at least at FIGS. 2 and 3 and paragraphs [0024], [0028] and [0031] of the present application, and therefore no new matter has been presented.

Claims 1-12, 18-26, 28, 30, 32-43, 47-51, 53, 54 and 55-59 are therefore pending in the present application. Claims 1, 4, 18, 28, 47, 49, 51 and 55 are independent claims. Applicant requests reconsideration and allowance of the present application in view of the present amendments and the following remarks.

ALLOWABLE SUBJECT MATTER:

Claims 58 is objected to but is indicated as allowable if rewritten in independent form. Applicant will hold the rewriting of the claim in abeyance until the arguments presented herein have been considered.

REJECTION UNDER 35 USC §§ 102 & 103:

Claim 55 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U. S. Patent No. 6,160,787 to Marquardt Jr. et al. ("Marquardt"). Claims 1-12, 19-26, and 47-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,825,726 to Hwang et al. ("Hwang") in view of U. S. Patent No. 6,205,112 to Weidner ("Weidner") and further in view of Marquardt. Claims 18 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hwang in view of Marquardt. Claim 50 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hwang in view of Weidner and further in view of Marquardt. Claims 28, 30, 36-43, 51, 53, and 54 are rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,754,248 to Faroudja ("Faroudja"), in view of Hwang in further in view of Weidner and in further in view of Marquardt. Applicant respectfully traverses the rejections.

Amended independent claim 18 recites at least the following:

a single side of the disc on which a plurality of data are sequentially recorded on a single surface of the disc in various corresponding disc recording formats such that data of each disc recording format is recorded in a different radial portion of the disc;

Hwang, Weidner Marquardt and Faroudja, taken separately or in combination, fail to suggest or disclose at least the above-recited features of amended independent claim 18.

The Office Action notes at page 12, item 4, that Hwang "does not teach multiple recording formats on a single side of the disc." However, the Office Action proposes to modify Hwang with Marquardt, and asserts that Marquardt compensates for the deficiencies of Hwang by teaching "multiple recording formats on a single side of the disc" at figure 5.

Marquardt is directed to an optical disk recording different data formats on two distinct surfaces or layers of a compact disc. The layers/surfaces are separated by a thin film of wavelength sensitive material (col. 2, lines 8-10). One layer/surface is used to record CD data and the second layer/surface is used to record DVD data. Consequently, Marquardt does not describe "a single side of the disc on which a plurality of data are sequentially recorded on a single surface of the disc in various corresponding disc recording formats." Further, Marquardt does not suggest that "data of each disc recording format is recorded in a different radial portion of the disc." This is because in Marquardt, it would be typical for data of two different formats to be recorded in the same radial portion of the disc since the CD data layer is recorded on top of the DVD data layer, or vice-versa. Accordingly, Marquardt fails to suggest or disclose all of the above-recited features.

Weidner fails to compensate for the deficiencies of Hwang and Marquardt because Weidner only describes a disc having data encoded in a first format on one side and data encoded in a second format on the opposing side (see col. 4, lines 1-30).

Faroudja fails to compensate for the asserted deficiencies of Hwang, Weidner and Marquardt.

Accordingly, Applicant respectfully submits that amended independent claim 18 patentably distinguishes over Hwang, Marquardt, Weidner and Faroudja and should be allowable for at least the above-mentioned reasons. Since similar features recited by each of the amended independent claims 1, 4, 18, 28, 47, 49, 51 and 55, with differing scope and breadth, are not taught or disclosed by Hwang, Marquardt, Weidner and Faroudja, the rejection should be withdrawn and claims 1, 4, 18, 28, 47, 49, 51 and 55 also allowed.

Further, Applicant respectfully submits that claims 2, 3, 5-12, 20-26, 30, 36-39, 40-43, 48, 50, 53, 54, 56, 57 and 58, which variously depend from independent claims 1, 4, 18, 28, 47, 49, 51 and 55, should be allowable for at least the same reasons as the independent claims, as well as for the additional features recited therein.

No Reason to Combine

Applicant respectfully submits that the rejection fails to establish a prima facie case of obviousness. To establish a prima facie case of obviousness, there must be: 1) some suggestion or motivation to combine the references; 2) a reasonable expectation of success; and 3) the references must teach or suggest all the claim limitations. MPEP 2143.

Here, no citation to the prior art has been offered as providing a suggestion or reason to modify Hwang, Weidner Marquardt and Faroudja, nor does the Office Action provide evidence demonstrating an implicit motivation to modify the references. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 127 SCt 1727, 167 LEd2d 705 (U.S. 2007), the U.S. Supreme Court held that in determining obviousness, it is necessary “to determine whether there was an apparent reason to combine the known elements in the fashion claimed” *KSR*, slip op. 14, 82 USPQ2d at 1396. Further, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR* at 1396, quoting *In re Kahn*. The reasoning provided in the Office Action for combining Marquardt with Hwang, Weidner and Faroudja states at page 15:

“None of them but Marquardt, Jr. et al., teaches multiple recording formats on a single side of the disc (figure 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the concept of recording different formats on a single side of a disc as taught by Marquardt, Jr. into the system of Faroudja in view of Hwang et al. in view of Weidner. The motivation would be to have a medium readable by different types of players.”

Applicant asserts that the cited rationale for combining Marquardt with Hwang, Weidner and Faroudja is merely a conclusion and therefore fails to meet the standard articulated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* Applicant respectfully submits that this amounts to an improper hindsight reconstruction of the invention.

Further, according to MPEP 2143.01, where the teachings of two or more references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991).

Weidner is directed to “a dual-sided optical disc having different formats, such as CD data and DVD data, on opposing sides” (col. 2, lines 15-18).

In contrast, Marquardt is directed to an optical disk recording different data formats on two distinct layers on a compact disc, separated by a thin film of wavelength sensitive material

(col. 2, lines 8-10). One layer is used to record CD data and the second layer is used to record DVD data.

Accordingly, Weidner and Marquardt take two conflicting approaches to recording data having different formats to a disc. However, the Office Action fails to “weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another,” as required by MPEP 2143.01.

Referring now to Faroudja, Applicant respectfully asserts that the Office Action fails to establish that Faroudja is analogous art. For art to be analogous, it must be in the field of Applicant's endeavor or reasonably pertinent to the problem to be solved. *MPEP 2141.01(a)(I)* The rejection fails to establish that Faroudja is in the same field of endeavor. Further, Applicant asserts that Faroudja is not reasonably pertinent to the problem that the present claims seek to address for at least the following reasons.

Faroudja is directed to a “universal” recording and transmission system in which both 24 fps (or 25 fps) motion picture film sources and non-film interlaced or progressively-scanned video sources, employing any one of several international television standards (e.g., NTSC, PAL, HDTV/ATV, etc.), are all recorded or transmitted as progressively-scanned video at a nominal frame rate of 24 or 25 frames per second (i.e., 24 Hz or 25 Hz) (col. 2, lines 19-28). Thus, Faroudja relates to varying display formats rather than varying “recording formats” as claimed. Further, Faroudja expressly states at col. 6, lines 39-42, that “the details of the video disc itself and the manner of applying and extracting data from the disc are not the subject of the invention.” Consequently, the Office Action fails to establish that Faroudja is analogous art.

Accordingly, for at least the reasons described, the Office Action fails to establish that one skilled in the art would have had a reason to combine the teachings of Hwang, Weidner, Marquardt and Faroudja, and the rejection under 103(a) is improper.

REQUEST FOR ENTRY IN ACCORDANCE WITH 37 CFR 1.116:

Entry of this Amendment in accordance with 37 CFR 1.116 is respectfully requested. Applicant submits that this Amendment After Final Rejection places the subject application in condition for allowance. This Amendment was not presented earlier because Applicant believed that the prior Amendment placed the subject application in condition for allowance. Accordingly, entry of the instant Amendment as an earnest attempt to advance prosecution and reduce the number of issues under appeal is requested under 37 C.F.R. § 1.116.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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